

precoded remote control transmitter for generating and transmitting a non-user-programmable, digitally encoded radio frequency signal representative of a multiple-bit transmitter code, the transmitter code being precoded so that a system user is not required to encode the transmitter or know the transmitter code. These claims further include a radio frequency receiver responsive to the radio frequency transmitter signal to provide receiver signals indicative of the transmitter code, and a system control unit disposed within the vehicle and having control over the vehicle antitheft apparatus, the control unit comprising: a digital memory; programming apparatus responsive to the receiver signals for recording in the memory only during a programming mode the transmitter code as a signature control signal for arming or disarming the vehicle antitheft apparatus, operating apparatus operable during a system security operating mode and responsive to the receiver signals for comparing the receiver signals to the recorded signature control signal and arming the vehicle antitheft apparatus upon a first receipt and recognition of receiver signals corresponding to the signature control signal, and for disarming the antitheft apparatus upon a second receipt and recognition of receiver signals corresponding to the signature control signal.

None of the references of record describe this invention, including the combination of a transmitter which transmits a non-user-programmable signal (Claim 95) or which is encoded by the manufacturer (Claim 99), with a system control unit which includes a programming apparatus and operating apparatus as set out in Claim 95. The entire thrust of Pinnow is that the user encode the transmitter. (This is so even of the "inexpensive unit having a minimum of features" described at column 6, lines 22-25.)

In the outstanding action, the Examiner discusses isolated passages of Pinnow:

1. Column 4, lines 31-42: Regarding Claim 95, the Examiner agrees that this passage does not suggest arming after receipt of an authorized code and subsequent disarming if another received code is correct. However, the Examiner asserts that this passage does suggest arming on receiving a code be it an authorized code or not, and further suggests that when the arming code is an authorized code, a disarming act will take place and the lock will open. Response: Pinnow does not suggest that receipt of any code be used for a purpose other than unlocking a lock. See column 3, lines 35-37 ("Upon a match of codes, the latching mechanism of the locking system would be opened."); and column 4, lines 47-50 ("Such a system would negate the need for separate ignition locks if the doors were always made to lock when shut when using the new universal electronic locking system) Column 4, lines 31-42 explicitly states that the receipt of a predetermined number of unauthorized code combinations would result in imposition of a delay before the processor could be addressed again by an optical transmitter. This is to make the time to sequence through all possible code combinations excessively long. This protective delay feature is explicitly stated to protect the lock from an unauthorized intrusion from a code sequencing device. Thus, the only teaching of this paragraph relative to the use of a code is to unlock the lock mechanism.

2. The Examiner asserts that Pinnow at Column 2, lines 1-3 discloses that it was known in the art to program a transmitter during manufacturing. Response: In the discussion entitled "Background of the Invention," U. S. Patent 3,872,435 was characterized as a reference which "discloses an opto-electronic security system wherein the key apparatus and the lock appara-

tus are precoded and which does not include an integral power source. The lock device code is preset during the manufacture by hard wiring the components to transmit only a factory-assembled code." Clearly, however, this teaching is of a system which is precoded, i.e. the key and the lock apparatus are precoded and permanently matched together. (See also applicant's specification at page 6, first two paragraphs.) This does not teach or suggest the desirability or advantages of a system comprising a hard-wired transmitter in combination with a programmable receiver which has the programming means set out in applicant's claimed invention.

3. The Examiner has asserted that Pinnow at column 3, lines 16-18 suggests that the transmitter "MAY" be reprogrammed, and this usage suggests that the transmitter need not be reprogrammed or can be preprogrammed during manufacturing. Response: The clear import of this passage is that the transmitter device have the capability of being reset or reprogrammed ("The invention further contemplates that such a device be capable of transmitting a plurality of different encoded codes, each of which may be reset or reprogrammed so as to allow the coded signal to be changed whenever desired." Column 3, lines 14-18, emphasis added.)

The Pinnow disclosure must be considered as a whole, and clearly the entire thrust of the Pinnow disclosure is that the user encode the transmitter. The import attached to the word "MAY" by the Examiner is at odds with the explicit teachings of the reference. Accordingly, non-user encoding and manufacturer encoding in the claimed system would not have been obvious.

Applicant has previously discussed the remaining cited references in prior responses. No further discussion of

these references is needed. None of the cited references, alone or in combination, teaches or suggests applicant's invention.

The claims depending from Claim 95 add further limitations distinguishing away from the cited references. For example, Claims 99 and 108 recite that the transmitter is encoded with the transmitter code by the manufacturer thereof, and thus the user need not learn how to encode the transmitter, in sharp contrast to the user-programmed code of Pinnow. Claim 104 recites that the operating apparatus is operable to perform a further function in addition to disarming the antitheft apparatus upon the second receipt and recognition of receiver signals corresponding to the signature control signal. Claim 105 defines this further function as including unlocking a vehicle access location lock. The cited references do not teach or suggest the features of the dependent claims.

In view of the foregoing discussion, the rejection under Section 103 should be withdrawn.

Objective Evidence of Nonobviousness.

Applicant has submitted declarations establishing objective evidence of nonobviousness. In a section 103 obviousness determination, such evidence must be considered if present, including the commercial success of the patented invention, whether the invention addresses long felt but unsolved needs, and the failures of others to produce alternatives to the patented invention. To be accorded substantial weight, a nexus must be established between the evidence and the merits of the claimed invention. "A prima facie case of nexus is generally made out when the patentee shows both that there is commercial success, and that the thing (product or method) that is commercially successful is the invention disclosed and claimed in the patent." In

re GPAC Inc., 35 USPQ 2d 116, at 1121-1122 (Fed. Cir. 1995) (quoting from Demaco Corp v. F. Non Lansdorff Licensing Ltd., 7 USPQ 2d 1222, at 1226 (Fed. Cir. 1988)).

Applicant has submitted herewith a further declaration of the inventor Ze'ev Drori and supporting exhibits to overwhelmingly demonstrate the nonobviousness of his invention. This declaration addresses points raised by the Examiner regarding the Declaration of Mr. Drori filed February 29, 1996. In the enclosed declaration, Mr. Drori conclusively establishes that:

1. The assignee Clifford Electronics, Inc. ("Clifford") diligently incorporated the invention in all newly designed remote control security systems introduced in the market after his invention. The technical features of the various Clifford systems which embody the invention are described in product literature included with the Drori declaration as Exhibit 1. (§1 of the Drori Declaration) Mr. Drori further established that Clifford completed the incorporation of his invention in all its remote control vehicle security systems as soon as it was commercially practical for Clifford to do so. (§1 of the Drori Declaration).

2. The outstanding commercial success of the invention was not due to special sales incentives to increase sales of the systems embodying the invention which were not offered to systems not embodying the invention. In fact, Mr. Drori states that after introduction of his invention, Clifford used once yearly clearance sales of old and discontinued remote control security systems, many of which did not include his invention. (§5 of the Drori Declaration)

3. The conventional systems outdated by the invention include those with transmitter and receiver

matched at the factory with a particular code by permanent wiring. (§ 3 of Drori Declaration)

4. The dealer/installer secures the product from the manufacturer (products are sold through independent retail dealers who employ technicians as installers to perform a professional installation) (§ 4 of Drori Declaration)

5. The use of Mr. Drori's invention by numerous other companies, including major vehicle manufacturers and virtually all aftermarket suppliers, is evidenced by product documentation set out in Exhibits 2-4.

The extensive objective evidence provided by Mr. Drori's declarations clearly establishes that there is a broad commercial success. The declaration and evidence establishes that the commercial success was brought by the invention. The evidence powerfully demonstrates not only Clifford's rapid adoption of the invention into its entire product line of remote control vehicle security systems, but the adoption of the invention by many competitors and vehicle manufacturers as well.

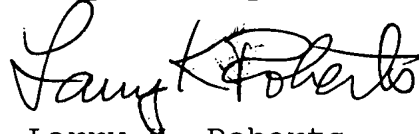
Accordingly, both parts of the two-part GPAC test are resoundingly answered.

INFORMATION DISCLOSURE STATEMENT UNDER 37 CFR 1.97(c)

Submitted herewith is a PTO 1449, with a copy of French Patent 2,580,128, and a translation thereof, recently brought to applicant's attention in litigation involving 5,146,215. Copies of references cited in a search report for a corresponding European application (EP 0306598) are also enclosed; these search report references were made of record in the prosecution of the '215 patent. It is requested that this information be made of record in this application.

Applicant respectfully submits that in view of the foregoing discussion of Pinnow, and in view of the evidence submitted by the accompanying declaration, that the obviousness rejection should now be withdrawn, and the case allowed. Such favorable action is now solicited.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Larry R. Roberts".

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